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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/766,984
Filing Date: January 29, 2004
Appellant(s): ZIEGLER ET AL.

Robert Holland
For Appellant

EXAMINER'S ANSWER

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

As per the Advisory Action mailed 2/11/08, claims 1-9, 19-20 have been canceled. The outstanding rejections regarding claims 1-9, 19-20 under 35 USC § 101, 102 and 103 grounds are now moot as well as the claim objections regarding claim 3. The remaining grounds of rejection of claims 10-18 to be reviewed on Appeal are deemed correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

7,146,640	Goodman et al	12-2006
7,000,230	Murray et al	2-2006

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 10, 13, 15-18 are rejected under 35 U.S.C. 102(e) as being anticipated by
Goodman et al. USPN: 7,146,640 (hereinafter Goodman).

As per claim 10, Goodman discloses a method for creating an operating system image, the image having integrated updates (e.g. *SOS software image* - col. 9, § 1.2; col. 7, lines 34-44, 55-60; V-drive 116, SOS 126, SOE 120 - Fig. 4B), the method comprising:

removing the source file of the operating system (e.g. *shutdown* § 1.4, col. 11; § 3.3.4.1, col. 17 – Note: shutdown/deleting a whole secondary OS partition by user to create a fresh one reads on removing of at least one file -- *shall be deleted* -§ 3.3.1 col. 17; *deleted ... shall be replaced with a fresh copy* – § 3.2.2.1, col. 15);

extracting an update file from an operating system update (e.g. *user ... transfer selected files from the SOS to the primary operating system* - col. 11, § 1.3.2 – Note: Safe mode option

and access extension enabling the user to only transfer selected files SOS or SOE to the primary OS reads on *extracting update file* from the SOE or SOS; see *complete copy, applications that are necessary* - col. 7, line 48 to col. 8, line 9 – Note: opting for a complete duplicate source OS or only some ancillary applications for populating a SOE reads on *extracting* an update file);

writing the update file over a corresponding operating system file (see *transfer selected files from the SOS to the primary operating system* - col. 11, § 1.3.2 - Note: transferring files from OS from isolated duplicate SOS/SOE --in a safe mode -- onto a primary S operating system – § 3.4.1.1, col. 17 - reads on writing the update file in this SOE partition for any corresponding OS file in said primary OS; this writing also taught in updating the POS based on files in the temporary SOS – see col. 15 § 3.2.2.3; *update POS files*, Fig. 8G);

booting the operating system and registering the update with the operating system (e.g. col. 8, lines 15-32; § 3.1, col. 13; *Primary OS/Registry, DLL Registrations ... reboot ... complete installation* – § 3.1, col. 13; § 3.2.5 col. 15).

As per claim 11, Goodman discloses wherein the operating system has a primary and a secondary source files (e.g. POS, SOE – col. 6, line 58 to col. 7, line 8; Fig. 8D), the operating system preparation engine further operable to remove the primary source file (e.g. col. 7, lines 55-60), the update file writing a source file over the secondary source file (e.g. *transfer or load a desirable ancillary application to the secondary operating environment* - col. 11, § 1.3.2; col. 7, lines 1-8, 61-66, col. 8, lines 28-32 – Note: identifying a corresponding file in the off-the-shelf OS upgrade product or in primary OS and writing such file -- col. 7, lines 48-54 -- onto the SOE partition reads on update file overwrite secondary source file – refer to claim 1).

As per claim 13, Goodman teaches updates being a Quick Fix Engineering environment with files pertinent thereto (e.g. Fig. 8A-B, 8G – Note: creating an SOS image from a one download – see col. 11, § 1.3.2 or creating of an duplicate SOS - see Fig. 4B - to generate files installation of Windows and run just the SOS – Fig. 8A, 8D – for updating registry and file permissions – see Fig. 8B, 8E - reads on quick fix environment).

As per claim 15, Goodman discloses an alternative operating system operable to support the operation of the overwrite engine (e.g. col. 7, lines 1-10, li. 48-54; col. 8, lines 15-32; § 3.1, col. 13; Fig. 8G) to write update files over the operating system files.

As per claim 16, Goodman discloses an operating system image creation engine operable to copy the booted operating system as an image for use in manufacture (e.g. *SOS image ... delivered to user* -- § 3.2, col. 13) of information handling systems.

As per claim 17, Goodman discloses identifying a plurality of updates as security updates (see Internet Access permissions – Fig. 8B; *worms* – col. 19, lines 49-61; Fig. 8E) and non-security updates (see Fig. 8E-G); selecting the security updates for the extracting and writing (Fig. 8B, 8E); installing the non-security updates after boot of the operating system (e.g. *Primary OS/Registry, DLL Registrations ... reboot ... complete installation* – § 3.1, col. 13; § 3.2.5 col. 15).

As per claim 18, Goodman discloses wherein the security updates are patches to protect worm vulnerabilities (e.g. *worms* – col. 19, lines 49-61).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman et al.

USPN: 7,146,640.

As per claim 14, Goodman discloses extracting an update file further comprises extracting a file to support recognition of the update file by the operating system (see col. 11, § 1.3.2; Fig. 8B, 8E) but does not make it explicit that update package engine further operable to include the digital signature files with the update files; but based on the access permissions and *extensions* of file to check on innocuous code intrusion (see § 2.6 col. 13; *decryption* – col. 13, § 3.1) and decrypting proper identification of downloaded package content, the security aspect involving verifying the propriety or identity of a file and its rightful state is suggested. It would have been obvious for one skill in the art at the time the invention was made to implement the *decryption* of package or verifying the access permission of Goodman so that this verification process includes extracting signature of a file, because downloaded package can be subject to innocuous alteration and only through decryption of a hash or a CRC or signature can the verification sturdily establish whether the downloaded file is integral or has been altered therefore no longer proper for use, such as this endeavor has been suggested above.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman et al.

USPN: 7,146,640; in view of Murray et al., USPN: 7,000,230 (hereinafter Murray)

As per claim 12, Goodman does not explicitly disclose wherein the primary source file comprises the *DLLCACHE* and the secondary source file comprise *I386*. But Goodman discloses updating files package for activation in a Windows systems (§ 1.3, col. 11 Note: this is suggestive of *I386* directory) and setting DLL modifications after a reboot (§ 3.1, col. 13; § 3.2.5 col. 15). The providing of a DLL cache (Fig. 11; cache directory – col. 12, lines 2-6) to store downloaded upgrade package is taught in a similar system by Murray analogous to the package downloading and loading of Windows POS of Goodman. It would have been obvious for one skill in the art at the time the invention was made to provide a overwriting of the primary Operating system (POS) with package files such as the DLLs by Murray by replacing the DLL cache or replacing *I386* related files in Windows systems because of the need to provide an equivalent functionality (see Goodman: col. 15; col. 8 li. 15-32) of the Windows systems when all files (like DLLs as taught by Murray cache directory) or *I386* files (as suggested above) are installed and registered so that Goodman's SOS truly provides the exact corresponding functionality of the Windows systems being upgraded, as in upgrade of Window registry of the downloaded files (§ 3.1, col. 13; § 3.2.5; col. 15; col. 8 li. 15-32)

/----- end of Grounds of Rejection ----/

(10) Response to Argument

35 USC § 102(e) Rejection by Goodman et al:

(A) Appellants have submitted that Goodman fails to disclose or suggest 'extracting an update file from and operating system update', and based on the Office action's cited portions of which secondary OS is kept separate from the primary OS to allow Internet access, wherein

malicious code definition would not be needed in Goodman, Goodman updates does not have 'extracted update file from an operating system update' (Brief, pg. 3).

(B) Claim 10 recites (i) 'image having integrated updates', (ii) 'removing the source file of the operating system', then (iii) 'extracting an update file from an operating system update', then (iv) 'writing the update file over a corresponding operating system file'. In terms of interpreting the action of *extracting* from an OS update, the claim language provides no further details than 'extracting', 'an update file', 'an operating system update', rendering step (iii) disjoint from the prior setting in the claim, i.e. disconnection in terms of time and structural relationship. That is, as construed from (i) and (ii), there is no remote structural relationship between 'an operating system update' and (i) and (ii) in terms of slightest language referencing from (iii) into each of (i) and (ii), i.e. in terms of referencing subsequently claimed entities to a previously recited entities. Therefore, broad reasonable interpretation has been used. As interpreted, step (ii) is taken as though the removal step is for initializing one upgrade process; and prior to the writing of step (iv), an extracting step (iii) is considered.

(C) Regarding this, the interpretation has been as follows.

Claims 10-18 in their present form have multiple interpretations which the Examiner will address herein. The cited claims are method claims that use the transitional term "comprising". According to MPEP § 2111.03 [R3]

The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., > Mars Inc. v. H.J. Heinz Co., 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term comprising," the terms containing' and mixture' are open-ended."); < Invitrogen Corp. v. Biocrest Mfg., L.P., 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition comprising' in a method claim indicates that the claim is open-ended and allows for additional steps."); Genentech, Inc. v. Chiron Corp., 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim

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language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd.App. 1948) (“comprising” leaves “the claim open for the inclusion of unspecified ingredients even in major amounts”). >In *Gillette Co. v. Energizer Holdings Inc.*, 405 F.3d 1367, 1371-73, 74 USPQ2d 1586, 1589-91 (Fed. Cir. 2005), the court held that a claim to “a safety razor blade unit comprising a guard, a cap, and a group of first, second, and third blades” encompasses razors with more than three blades because the transitional phrase “comprising” in the preamble and the phrase “group of” are presumptively open-ended. “The word ‘comprising’ transitioning from the preamble to the body signals that the entire claim is presumptively open-ended.” *Id.* In contrast, the court noted the phrase “group consisting of” is a closed term, which is often used in claim drafting to signal a “Markush group” that is by its nature closed. *Id.* The court also emphasized that reference to “first,” “second,” and “third” blades in the claim was not used to show a serial or numerical limitation but instead was used to distinguish or identify the various members of the group. *Id.*<

Thus the cited claims do not exclude additional, unrecited elements or method steps from being within the embodiment of the invention. In addition, only a few of the claims steps have any inter-relationship to one another that put restrictions on how it is intended to be interpreted. The claims limitations / steps have at least two interpretations, both of which will be addressed below.

First, the cited art of record allows for one or all of the files of an operating system to be updated and sent to another system / operating system for loading and execution. The files of the operating system are modified by manipulating a master file image such that any modifications are stored and applied to future secondary operating systems (col. 11, § 1.3.2; lines 13-26) and are loaded when the secondary operating system is executing in a safe mode. Since the claims are open-ended and some steps do not portray the order in which they are processed, the claims could very well remove all of the files of an operating system by removing the currently executing secondary operating system on the secondary device at any time (col. 11, § 1.4; i.e. before loading a new copy or removing the new copy from memory) while allowing users to modify the master copy secondary operating system file (col. 13, § 3.1; col. 17, § 3.4.1.1 The user shall be able to modify the SOS Master file.) such that any future creations of an operating system, extracts (copies) the updates from the updated operating system master file (col. 13, §

3.1 The operational copy of the SOS shall be a copy of the master copy of the SOS as it exists in the POS; col. 1, § 3.3.3, A new copy of the SOS shall be created from the Master SOS Image folder."); writes the updated files over the section of memory where a previous operating system was loaded and executing and boot-up (col. 17, § 3.3.1, "Create a fresh copy of SOS Image File wherein partition is deleted when the SOS is terminated and replaced with a fresh copy of the SOS operating system partition at each start-up of the SOS) and run that new operating system instance (start-up of the SOS). The update is registered when the changes is made to that master operating system instance during safe mode. This is clearly shown by the teachings of the references as indicated herein.

Assuming also that only a portion of the files are removed while the remaining are maintained (which is not directly claimed and cannot be the basis for the only possible interpretation since by doing such would violate M.P.E.P. 2111 regarding reading in limitations into the claims), Goodman teaches upgrade of an target operating system using a partition or isolated portion of the hard drive called SOE (Software Operating Environment) wherein creation of this SOE entails user selection, and depending of the upgrade mode, files from this SOE are checked for validation then, via user selection (emphasis added) transferred to for updating the primary OS (e.g. col. 11, § 1.3.2; col. 15 § 3.2.2.3; col. 17, § 3.4.1.1 as set forth in the rejection). User's selection as to which particular application files or SOE files – as opposed to mass transfer the totality of source files to and from the POS -- would be needed for the upgrade (as set forth above and in the rejection) can be viewed as selective extracting act operating upon a number of SOE files, such that this selective act is based on user's knowledge or criteria. Thus, based on the interpretation of 'extracting an update file from an operating

system update' as set forth, Goodman is deemed teaching user's *extracting* one file among others in the isolated operating environment (SOE).

(D) Further, regarding the language of (iii) (i.e. 'extracting an update file from an operating system update'), the claimed language allows the following observation.

First, absent any more specifications to further define what 'update' consists of, an 'operating system update' is viewed as a source of resources destined to provide files needed for upgrading a target O.S. When files are provided as source as thus understood, the act of obtaining one file from any larger plurality of files entails a selective act of narrowing down on a specific file among such plurality, and this act is deemed opposed to indiscriminately gathering the whole collection of files as in one step, i.e. applying a more or less intelligence in performing such selecting. Second, in lexicographic sense with regard to 'extracting', one would expect a plurality of files or amount of objects to be introduced as a container (e.g. in a particular form such as a compaction or package), such that the action of retrieving (pulling out) one object among such package plurality would have to be based on some intelligence, some utility, or selection criteria; such action being an extraction. The claim as recited in (iii) does not fulfill one or both of the above expected aspects of what the concept of extraction entails. Third, 'an update file' is interpreted as one file that, when properly in place prior to a upgrade process, would be part of the process of upgrade in which the file would be used, e.g. to support the upgrade or to be part of the transferring between old and new operating system.

(E) Referring to the teachings by Goodman used in the Office Action, Goodman teaches upgrade of an target operating system using a partition or isolated portion of the hard drive called

SOE (Software Operating Environment) wherein creation of this SOE entails user selection, and depending of the upgrade mode, files from this SOE are checked for validation then, via user selection (emphasis added) transferred to for updating the primary OS (e.g. col. 11, § 1.3.2; col. 15 § 3.2.2.3; col. 17, § 3.4.1.1 as set forth in the rejection). User's selection as to which particular application files or SOE files – as opposed to mass transfer the totality of source files to and from the POS -- would be needed for the upgrade (as set forth above and in the rejection) can be viewed as selective extracting act operating upon a number of SOE files, such that this selective act is based on user knowledge/criteria in light of how extracting is deemed understood, as analyzed in section D. Thus, based on the interpretation of 'extracting an update file from an operating system update' as set forth in section D, Goodman is deemed teaching user's extracting one file among others in the isolated operating environment (SOE).

(F) In regard to claim 10 as a whole, Goodman teaches shut down by *a)* deleting a temporary SOS partition (§ 3.3.4.1, col. 17; § 3.2.2.1, col. 15) and creating a fresh SOE, whereby the files being included to form this SOE would be necessary in view of *b)* user's selection; then based on which, Goodman's process runs the secondary operating system SOS and using user selected files *c)* update the Primary OS by write over the primary OS files for finalizing this primary OS before rebooting - see col. 11, § 1.3.2; § 4.2, col. 19; Fig. 8D. Thus, based on *a)* and *b)*, and *c)* the scenario by which among a plurality of files only some are selected – as in *b)*, Goodman's user selection is deemed equivalent to 'extracting' as broadly and unclearly defined in the claims.

The argument in (A) about Goodman not disclosing or suggesting 'extracting' as claimed in (iii) is not persuasive to overcome the rejection, mainly because of the lack of sufficient or

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specific details in the language of (iii) that would otherwise preclude teaching by Goodman, as set forth above, from reading into such insufficiently defined claimed limitation.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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